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EXAMINER

CARTER, MONICA SMITH

ART UNIT PAPER NUMBER

3722

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,909

Applicant(s)

BROYLES, LUCY

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-16 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, lines 6-7 appears to be incomplete (" said caption site, said caption site having...").

In claim 24, line 2, "said personalized text" lacks proper antecedent basis.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 12, 13, 17 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alspaw et al. ('730).

Alspaw et al. disclose a photograph display book comprising a plurality of pages (P) having binder (edges located adjacent binder 18) and outer edges (edges opposite binder 18); a photographic site (11) proximate the surface of at least one of the pages configured to receive a photograph (see col. 4, lines 14-20); a caption site (12)

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proximate the surface of at least one of the pages and corresponding to the photographic site (see col. 4, lines 21-27); and a binder (18) for securing selected ones of the plurality of pages proximate the binder edges to assemble a photograph display book (as seen in figure 1).

Alspaw et al. disclose the claimed invention except for the specific arrangement and/or content of indicia (for example, "each one of the plurality of pages related to a common theme" and the caption site being configured to receive text which is either personalized or repetitive throughout the pages) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the pages, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of page construction does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

The selected ones of said plurality of pages in said assembled repetitive language book relating to experiences of a pre-reader discloses the intended use of the

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book. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 2, see the above rejection regarding printed matter.

Regarding claim 12, Alspaw et al. disclose a photograph display book comprising a plurality of pages (P) having binder (edges located adjacent binder 18) and outer edges (edges opposite binder 18); a photographic site (11) proximate the surface of at least one of the pages configured to receive a photograph (see col. 4, lines 14-20); a caption site (12) proximate the surface of at least one of the pages having text imprinted thereon ("ALL ABOUT ME") and corresponding to the photographic site (see col. 4, lines 21-27); and a binder (18) for securing selected ones of the plurality of pages proximate the binder edges (as seen in figure 1).

Alspaw et al. disclose the claimed invention except for the specific arrangement and/or content of indicia (for example, the caption site being configured to receive text which is either personalized or repetitive throughout the pages) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the pages, since it would only depend on the intended use of the assembly and the desired information to be

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displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of page construction does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

The repetitive text imprinted within the caption site being selected to facilitate teaching of reading to a pre-reader discloses the intended use of the book. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 13, see the above rejections regarding printed matter.

Regarding claim 17, Alspaw et al. disclose a process for facilitating the reading skill of a pre-reader comprising the steps of providing a photograph display book comprising a plurality of pages (P) having binder (edges located adjacent binder 18)

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and outer edges (edges opposite binder 18); a photographic site (11) proximate the surface of at least one of the pages configured to receive a photograph (see col. 4, lines 14-20); a caption site (12) proximate the surface of at least one of the pages and corresponding to the photographic site (see col. 4, lines 21-27); and a binder (18) for securing selected ones of the plurality of pages proximate the binder edges (as seen in figure 1), selecting from the plurality of pages, pages suitable for memorialization of the experience; affixing the photographs proximate the photographic site of the page, providing the photographs with a message (to include a personalized message) and binding the pages with the binder. Inherently, when the photographs are affixed to the pages, an experience of the pre-reader will be recorded and/or memorialized.

Regarding claims 21-24, the caption site has personalized text imprinted thereon ("ALL ABOUT ME"). Regarding the text being repetitive text, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired text on the pages of the book, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of book does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for

patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding the personalized repetitive text being selected to facilitate teaching of reading to the pre-reader sets forth the intended use of the text. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

5. Claims 3-8, 14-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alspaw et al. in view of Illos et al. ('738).

Regarding claims 3, 14 and 18, Alspaw et al. disclose the claimed invention except for the binder being selected from the group consisting of lace, ribbon, string and yarn.

Illos et al. disclose a tamper-proof page assembly comprising a plurality of pages (10) having a ribbon binder (16) for securing the pages together. Illos et al. show that ribbon is an equivalent structure for binding pages known in the art. Therefore, because these two binding structures were ad-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute

ribbon for wire binding.

Regarding claim 4, Alspaw et al., as modified by Illos et al. disclose the caption site being configured to receive text (to include a personalized text corresponding to the pictorial representation of the corresponding photographic site) (see col. 4, 21-27).

Regarding claim 5, Alspaw et al., as modified by Illos et al., disclose the pages having at least one perforation proximate the binder edges for receiving the binder (as seen in figure 1 of Alspaw et al. and figure 1 of Illos et al.).

Regarding claim 6, Alspaw et al., as modified by Illos et al., disclose the claimed invention except for the photographic site and corresponding caption site being proximate facing pages when the book is open to the facing pages. It would have been obvious to one having ordinary skill in the art at the time the invention was made to position the photographic site and the caption site at any desired location on the pages, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claim 7, Alspaw et al., as modified by Illos et al., disclose the claimed invention except for photographic site and the corresponding caption site being proximate the same page (as seen in figure 2).

Regarding claim 8, Alspaw et al., as modified by Illos et al., disclose the pages comprising front (10) and rear (14) covers.

Regarding claim 15, Alspaw et al., as modified by Illos et al., disclose the claimed invention except for pages having at least one perforation proximate the binder edges, the binder being threaded through the perforations to form a loop, the ends of

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the binder being threaded through the loop and secured together for binding the pages along the binder edges for movement through an arc (as seen in Illos et al., figures 2 and 3).

Regarding claim 16, Alspaw et al., as modified by Illos et al., disclose pictorial representations proximate the photographic site and text (to include personalized text) proximate the caption site (as seen in figures 2 and 3 of Alspaw). The personalized repetitive text being selected to facilitate teaching of reading to the pre-reader sets forth the intended use of the text. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 19, see the above rejections to claims 8 and 15.

Regarding claim 20, it is inherent that the pages would be read to a pre-reader, since the pre-reader is not capable of reading the pages to himself/herself.

6. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alspaw et al. in view of Boehm ('522).

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Regarding claim 9, Alspaw et al. disclose the claimed invention except for the pages having two substantially parallel binder edges and a fold line between the binder edges for folding the pages to form a receptacle.

Boehm discloses a thematic bound scrapbook having pages (36) having two substantially parallel binder edges and a fold line (60) between the binder edges for folding the pages to form a receptacle (the sheet includes opening 72 for receiving a photograph or other item – see col. 4, lines 43-49). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Alspaw's invention to include folded pages, as taught by Boehm, to enable easy insertion and removal of photographs in the album.

Regarding claim 10, Alspaw et al., as modified by Boehm, disclose a border (20b) delineated by a cut away portion of the photographic site for receiving a photograph (as seen in figure 3).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alspaw et al. in view of Boehm and further in view of Galm ('770).

Alspaw et al., as modified by Boehm, disclose the claimed invention except for a plurality of cards having repetitive text printed thereon corresponding to repetitive text of the caption site of the pages and a container for storing the pages, binder and cards, the container being printed with text corresponding to the text of the caption site of the pages and configured to receive personalized text.

Galm discloses a greeting and thematic card kit comprising a plurality of greeting cards (30) having indicia (130) to be placed in envelopes (40), the greeting cards receive cards (20) having similar indicia (120); wherein the greeting cards, envelopes, and cards are retained in a container (50) having similar indicia (150) (as seen in figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Alspaw's invention to include cards and a container for receiving the cards and other items wherein the cards and container have corresponding indicia, as taught by Galm, to provide the display book with a convenient storage means.

Response to Arguments

8. Applicant's arguments filed July 12, 2004 have been fully considered but they are not persuasive.

Applicant disagrees with the examiner's conclusion that the printed matter required by the claims of the present application is not functionally related to the substrate.

In the present invention, the claimed repetitive language kit comprises a book having a binder for securing selected ones of a plurality of pages together. The invention comprises printed matter that has been printed onto a substrate where the printed matter does not convey any meaningful information in regard to the substrate and does not require any particular substrate to effectively convey the information.

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Thus, there is no meaningful functional relationship between the indicia and the substrate.

The examiner asserts that the photograph display book of Alspaw et al. comprising a binder for securing selected ones of a plurality of pages together is the same structure claimed by applicant and the sole difference is in the content of the printed material. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

The printed matter, therefore, has been considered; however, the examiner has determined that the claimed printed matter is not functionally related to the substrate, as stated above, and does not provide the functional relationship required for patentability.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 29, 2004

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER